# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/827,518 | 04/06/2001 | Patrick Urban | 7347-000001 | 6141 |

| | | | EXAMINER |
|---|---|---|---|
| 27572 | 7590 | 08/12/2004 | SCHLAIFER, JONATHAN D |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2178 | |

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/827,518 | URBAN, PATRICK |
| | Examiner | Art Unit | |
| | Jonathan D. Schlaifer | 2178 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>06 April 2001</u>.
2a) ☐ This action is **FINAL.**    2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-24</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-24</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>06 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All  b)☐ Some * c)☒ None of:

   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1.  This action is responsive to application 09/827,518 filed on 4/6/2001, with no prior art

    filed.

2.  Claims 1-24 are pending in the case. Claims 1, 8, 9, and 15 are independent claims.

    Claims 9, 11-12, 15, 17, and 19 have been amended by a preliminary amendment. Claim

    24 is a new claim from the preliminary amendment.

### *Priority*

3.  Acknowledgment is made of applicant's claim for foreign priority based on an application

    filed in Germany on 5/9/2000. It is noted, however, that applicant has not filed a certified

    copy of the German application as required by 35 U.S.C. 119(b).

### *Claim Objections*

4.  Claim 9 objected to because of the following informalities: In line 7, "display" should be

    "displaying" and in line 10, "even should be event". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

5.  Claim 1 is rejected under 35 U.S.C. 112, second paragraph because the wording of the

    claim is unclear, in that the claim begins by claiming a method, but fails to set forth

    specific steps of a method to be performed. Appropriate correction is required.

6.  Claim 22 is rejected under 35 U.S.C. 112, second paragraph because an apparatus cannot

    be embodied in a signal. For purposes of examination, the claim has been taken to refer

    to a data signal that embodies the method performed by the apparatus of claim 15.

## *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.  Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim describes a computer program only, without encoding in a computer-readable medium or any other tangible basis. Appropriate correction is required.

8.  Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim describes a computer data signal only, without hardware or any other tangible basis. Appropriate correction is required.

## *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9.  **Claims 1, 3-4, and 8 rejected under 35 U.S.C. 102(a) as being anticipated by Ladd et al. ("Using HTML 4, XML, and Java™ 1.2", Published by Que® on 12/23/1999), hereinafter Ladd.**

10. **Regarding independent claim 1,** Ladd discloses a method for a computer application having a sequence controller and a user interface on pages 561-562 (the code listing, 23.2 (a web page) refers to a sequence controller the applet controls a sequence of program

steps and a user interface (web page displays a user interface in a browser), the user

interface being produced by showing pages of a markup language (listing 23.2 is in

HTML), and at least part of the sequence controller being produced by programs which

can be embedded in pages of this markup language(the interface to the applet is

moderated by embedded JavaScript), characterized in that the page containing the

sequence controller and the page to be displayed which produces the user interface are

separate form one another (the applet page and listing 23.2 are separate from each other).

11. **Regarding dependent claim 3,** the page for the applet referred to by the JavaScript as

described in the rejection of claim 1 due to Ladd would not be visible to the user.

12. **Regarding dependent claim 4,** listing 23.2 as it stands in Ladd produces a display that is

not variable because all it displays are two buttons which affect a counter without

changing anything that is displayed.

13. **Regarding dependent claim 7,** data is transferred between the sequence controller and

the page to be displayed via JavaScript, which is a procedural interface.

14. **Regarding dependent claim 8,** it is a computer program that comprises the methods of

claim 1 and is rejected under similar rationale.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

15. **Claims 2, 5-6, 9-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ladd.**

16. **Regarding dependent claim 2,** Ladd fails to disclose on pages 561-562 that the counter variable is displayed. However, on page 501, Ladd discloses that JavaScripts can be used to present information. Since it was notoriously well known in the art at the time of the invention that displaying a counter provides useful feedback to the user, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used JavaScript to have displayed the counter in order to provide useful feedback to the user.

17. **Regarding dependent claim 5,** Ladd fails to disclose on pages 561-562 that a display program for the markup language provides for the display area to be split into frames, and a frame without variable contents is used for the sequence controller page. However, on pages 502-503 of Ladd, Ladd describes the use of frames and indicates that they can be used to regulate the display of content (Ladd also comments on the use of frames on pages 212-213). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used frames in conjunction with Ladd's other knowledge to isolate the sequence controller page's display into a frame without variable contents because the display would be without variable contents as per the rejection to claim 4, and the benefit of using frames is to allow "users to see different pages simultaneously" (Ladd, page 212).

18. **Regarding dependent claim 6,** Ladd discloses that the visual output is produced by means of the page which is to be displayed (web browsers inherently display the pages that they are displaying), but Ladd fails to disclose that all the other peripheral devices,

including keyboards or pointer devices, are controlled by the sequence controller.
However, since the sequence controller is a Java applet, it was notoriously well known in
the art at the time of the invention that with the appropriate permissions, a Java applet can
control any peripheral in a computer system in order to accomplish programmatic
functions. It would have been obvious to one of ordinary skill in the art at the time of the
invention to give a Java applet control over all peripherals in order to accomplish
programmatic functions.

19. **Regarding independent claim 9,** it is essentially a unification of the limitations from
claims 1 and 2 and is rejected under the same rationale. One subtle variation, the event-
handling procedures, is present in claim 9, but this limitation would have been inherent to
the art cited to reject claims 1 and 2.

20. **Regarding dependent claim 10,** Ladd fails to disclose that the sequence controller page
produces a user display apart from the user interface page, however it was notoriously
well known in the art at the time of the invention that Java applets can launch windows to
support their operation. It would have been obvious to one of ordinary skill in the art at
the time of the invention to have Java applets launch windows separately from the basic
user interface window because this would have opened opportunities for advanced
interaction with the user.

21. **Regarding dependent claim 11,** it modifies claim 10 in the way claim 4 modifies claim
1 and is rejected under similar rationale.

22. **Regarding dependent claim 12,** it modifies claim 9 in the way claim 5 modifies claim 1
and is rejected under similar rationale.

23. **Regarding dependent claim 13,** it modifies claim 9 with a subset of the limitations

claim 6 uses to modify claim 1 and is rejected under similar rationale.

24. **Regarding dependent claim 14,** it modifies claim 9 in the way claim 7 modifies claim 1

and is rejected under similar rationale.

25. **Regarding independent claim 15,** it is an apparatus that performs the method of claim 9,

and it is rejected under similar rationale.

26. **Regarding dependent claim 16,** it is an apparatus that performs the method of claim 10,

and it is rejected under similar rationale.

27. **Regarding dependent claim 17,** it is an apparatus that performs the method of claim 11,

and it is rejected under similar rationale.

28. **Regarding dependent claim 18,** it is an apparatus that performs the method of claim 9,

with added limitations from claim 3, and it is rejected under similar rationale.

29. **Regarding dependent claim 19** it is an apparatus that performs the method of claim 12,

and it is rejected under similar rationale.

30. **Regarding dependent claim 20** it is an apparatus that performs the method of claim 13,

and it is rejected under similar rationale.

31. **Regarding dependent claim 21,** it is an apparatus that performs the method of claim 14,

and it is rejected under similar rationale.

32. **Regarding dependent claim 22,** it is a carrier wave that embodies the method performed

by the apparatus of claim 15, and it is rejected under similar rationale.

33. **Regarding dependent claim 23,** Ladd fails to disclose that the network was the Internet.

However, it was notoriously well known in the art at the time of the invention that Web

transactions were carried out on the Internet to facilitate remote connectivity. It would

have been obvious to one of ordinary skill in the art at the time of the invention to use the

Internet to facilitate remote connectivity.

34. **Regarding dependent claim 24,** it is the method of claim 3 modified with limitations

from claim 5 and it is rejected under similar rationale.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

USPN 6,112,212 (filing date 9/15/1997)—Heitler

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777.

The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 703-308-5465. The fax phone number for the

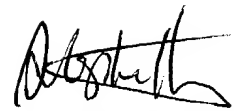organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS

STEPHEN S. HONG
PRIMARY EXAMINER